

REMARKS

In response to the Official Action mailed June 13, 2007, Applicant respectfully requests reconsideration, reexamination and allowance of claims 1, 7 and 9 in view of the above amendments and the following remarks.

The Examiner rejected claims 1 and 7 under 35 U.S.C. 102(b) as being anticipated by Jansen (US 4,303,571). The Examiner stated that Jansen teaches a film form composition comprising 25-55 parts by weight of EPM or EPDM elastomer, about 35-55 parts by weight of EVA, about 15 -25 parts by weight of a hydrocarbon plasticizer and about 0-30 parts by weight of calcium carbonate as a filler, and about 0.5-2 percent by weight of a film processing slip agent or adherent based upon the weight of the total blend. The Examiner states that the aforementioned elements read upon the claim language of the instant invention: a desirably shaped body of a heat-activatable sealant, the sealant formulated from a first polymer, the first polymer being an ethylene vinyl acetate copolymer in a concentration of about 25 percent to about 30 percent of the sealant, a calcium carbonate inert mineral filler material in a concentration of about 25 percent to 30 percent of the sealant, a second polymer, the second polymer being an ethylene polymer other than an ethylene vinyl acetate copolymer in a concentration of about 20 percent to about 35 percent of the sealant and a hydrocarbon resin in a concentration of about 1 percent to about 15 percent of the sealant.

The Applicant strongly disagrees with the Examiner's characterization of the Jansen patent as reading on the aforementioned claim: if Jansen's chemical composition reads on the claim language of the present invention, Jansen's chemical composition would not retain the properties necessary to be suitable for its intended purpose – being capable of processing in a tubular blown film apparatus.

“The presumption of obviousness based on a reference disclosing structurally similar compounds may be overcome where there is evidence showing there is no reasonable expectation of similar properties in structurally similar compounds. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (appellant produced sufficient evidence to establish a substantial degree of unpredictability in the pertinent art area, and thereby rebutted the presumption that structurally similar compounds have similar properties); *In re Schechter*, 205 F.2d 185, 98 USPQ

144 (CCPA 1953). See also *Ex parte Blattner*, 2 USPQ2d 2047 (Bd. Pat. App. & Inter. 1987) (Claims directed to compounds containing a 7-membered ring were rejected as *prima facie* obvious over a reference which taught 5- and 6-membered ring homologs of the claimed compounds. The Board reversed the rejection because the prior art taught that the compounds containing a 5-membered ring possessed the opposite utility of the compounds containing the 6-membered ring, undermining the examiner's asserted *prima facie* case arising from an expectation of similar results in the claimed compounds which contain a 7-membered ring.).” MPEP 2144.09. A *prima facie* case of obviousness can only exist where the claimed ranges and prior art ranges do not overlap, but are close that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Thus, if the ranges do not overlap and the resulting compounds do not exhibit the same properties, there is no *prima facie* case of obviousness.

In this case, there is no overlap of ranges and the properties of the resulting compounds are not the same and therefore, a *prima facie* case of obviousness cannot be substantiated.

First, the present invention claims 25-30% of ethylene-vinyl acetate copolymer; Jansen discloses 35-55 parts by weight. As is known in the art, the solvent resistance decreases with increasing vinyl acetate content; therefore, by decreasing the level of the ethylene-vinyl acetate in the Jansen invention to a range of 25-30%, the Jansen invention would not have the resulting characteristics necessary to be suitable for a tubular blown film apparatus. Thus, Jansen's 35-55 part by weight cannot read upon the present invention's claim of using 25-30% ethylene-vinyl acetate.

Second, the present invention claims 1-15% of hydrocarbon resin; Jansen discloses 15-25 parts by weight of hydrocarbon processing oil. Not only do the ranges of the elements not overlap, the elements of the claims themselves are completely different – one is a resin and one is an oil. Substituting a hydrocarbon oil for a hydrocarbon resin results in a compound with differing characteristics from the compound intended.

The American Composites Manufacturers Association defines a resin as a solid or pseudo solid material with indefinite and often high molecular weight and a softening or melting range that exhibits a tendency to flow when subjected to stress. On the other hand, hydrocarbon

process oils, particularly the aromatic process oils as Jansen claims, have good solvency characteristics; their applications include ink oils, and extenders in synthetic rubbers. Naphthenic process oils are characterized by low pour points and good solvency properties; their applications include rubber compounding, printing inks, textile conditioning, leather tanning, shoe polish, rust proofing compounds, and dust suppressants. Paraffinic process oils are characterized by low aromatic content and light color; their applications include furniture polishes, and ink oils. As can be deduced from the characteristics of the resin and oil, substitution of a resin for the oil in Jansen would result in a composition that would not exhibit the properties needed for a tubular blown film; therefore, Jansen could not have anticipated the present invention.

The Examiner next rejects claim 9 under 35 U.S.C. 103(a) as being unpatentable over Jansen in view of adherent material properties known in the art. The Examiner admits that Jansen does not specifically teach that the adherent is an epoxy resin with an activator as the present invention claims. The Examiner states, however, that epoxy resins are an obvious species of an adherent material utilized in the art, wherein an activator is commonly utilized with the epoxy resin in sufficient amount such as the claimed less than 1%, to activate the 2% epoxy resin.

When a resin and an activator are mixed together, a chemical reaction takes place to produce a thermosetting resin seal of a consistency that is inappropriate for use in a tubular, blown film apparatus as is indicated in Jansen; therefore, Applicant submits that Jansen could not anticipate adding an activator. Applicant submits that the Examiner may be using impermissible hindsight in her argument that it would have been obvious to add an activator to the resin.

In conclusion, Application submits that claims 1, 7, and 9 as presented above are in condition for allowance and earnestly solicits early indication of same.

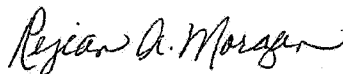
Applicant believes that no fee is due in connection with the present Amendment A. The Commissioner is, however, authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-2035.

Should the Examiner believe that a telephone interview would expedite prosecution and allowance of the present application, or address any outstanding formal issues, she is respectfully requested to contact the undersigned.

Serial No.: 10/612,091
Art Unit: 1773

Amendment F

Respectfully submitted,



By _____
Rejean A. Morgan
Reg. No. 54,322

August 24, 2007
LEVENFELD PEARLSTEIN, LLC
2 N. LaSalle Street
Suite 1300
Chicago, Illinois 60602
(312) 476-7505 Telephone
(312) 346-8434 Facsimile